

REMARKS

In the Office Action, claims 9-22 and 31-48 were rejected. By this response, claim 10 has been cancelled and claims 9, 11, 13, 15-17, 21, 31, 35, 40, 44 and 45 have been amended. Upon entry of these amendments, claims 9, 11-22 and 31-48 will be pending in the present application. Reconsideration of the rejections and allowance of the pending claims are respectfully requested.

Rejection Under 35 U.S.C. § 112

In the Office Action, claims 9-22 and 35-40 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 9, 35, and 40 have been amended in light of the Examiner's comments. Withdrawal of the rejection is respectfully requested.

Rejection Under 35 U.S.C. § 102

In the Office Action, claims 44-48 were rejected under 35 U.S.C. § 102(e) as being anticipated by Barnes et al., (hereinafter "Barnes"), U.S. Patent No. 5,970,475. Claims 44 and 45 have been amended by this response.

Claims 44-48 are patentable because the cited reference does not disclose all of the recited features of the claims. For example, Barnes does not disclose "*a publicly-accessible website operable to provide employees of an employer with a selection of products authorized by the employer for ordering and to enable the employees to order a product from the selection of products,*" as recited in amended independent claim 44. (Emphasis added).

In contrast, the Barnes reference discloses an electronic commerce system 10 where buyers communicate with suppliers over the Internet 14. *See Barnes*, col. 6, lines

6-17; col. 13, lines 5-8. However, it is a closed communication system because traffic is permitted only among pre-established and specially configured computers.” *See Barnes*, col. 13, lines 17-19. Customer (and other) computer equipment not running system software cannot establish a communication link. *Barnes*, col. 13, lines 19-21. Therefore, the electronic communication system 10 of *Barnes* is not a *publicly accessible website*, as recited in amended independent claim 44. Accordingly, the *Barnes* reference does not disclose all of the recited features of amended independent claim 44.

In view of the above remarks, *Barnes* does not anticipate amended independent claim 44. Therefore, claims 45-48, which depend from claim 44, also are not anticipated by the *Barnes* reference. Withdrawal of the rejection and allowance of claims 44-48 are respectfully requested.

First Rejection Under 35 U.S.C. § 103

Claims 9-22, 31-37, and 39-43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *King, Jr. et al.* (hereinafter “*King*”), U.S. Patent No. 5,319,542, in view of *Gardner et al.* (hereinafter “*Gardner*”), U.S. Patent No. 5,758,327. Claim 10 has been cancelled and claims 9, 13, 15-17, 21, 31, 35, and 40 have been amended by this response. Applicants respectfully traverse the rejection.

Claims 9, 11-22, 31-37, and 39-43 are patentable because the cited references, either alone or in combination, do not disclose or suggest all of the recited features of the claims and because there is no suggestion to combine the references. The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir.

1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Claims 9 and 11-22

In regard to independent claim 9, the Examiner stated that:

King, Jr. et al. (sic) show all elements of the claim except using a website to present the products or services for ordering. It is noted that King et al. show (sic) that a selection of authorized products is provided in the catalog and that only employees of can access the (sic) and order the catalog. Gardner et al. show a website interface. It is further noted that "for providing information...to a business's employees" is interpreted as mere intended use and that any web hosting system is capable of providing such information. *It would have been obvious to one of ordinary skill in the art to modify the system of King et al. by using a web interface in order to take advantage of existing infrastructure and to reduce training costs for learning a custom interface.*

(Emphasis added).

First, claim 9 is patentable because the cited references do not disclose or suggest all of the recited features of the claim. For example, the cited references do not disclose or

suggest “an electronic information system adapted to produce a publicly accessible website operable to provide job-function related information topics to employees of a plurality of businesses that access the website,” as recited in claim 9. (Emphasis added).

As the Examiner noted, the King reference does not disclose a website. Rather, the King reference discloses an electronic catalog ordering process and system. *See King*, col. 3, lines 15-17. The two major components of the electronic catalog ordering process and system are an electronic catalog and electronic requisition. *See King*, col. 3, lines 17-21. The electronic catalog is loaded and maintained by suppliers 100 *on their own local computer systems*. *See King*, col. 3, lines 40-45. Customers use mainframe computers with attached personal computer workstations to access the electronic catalog and order therefrom. *See King*, col. 6, lines 47-51 and col. 5, lines 37-48. There is no disclosure or suggestion in the King reference of providing job-function related *information* topics to any employees, including the employees of the customers. Furthermore, there is nothing in King to suggest that the electronic catalog ordering process and system is even accessible to any employee of any other business, other than an employee of the customers. *See King*, col. 3, lines 52-58 and col. 5, lines 37-48.

The Gardener reference discloses a central computer system 10 connected to a number of independent companies 12, 14, and 16. *See Gardner*, col. 4, lines 44-46. Within each company are potential requestors 18, 20, and 22. *See Gardner*, col. 4, lines 47-48. The requestors may be principals or employees of the individual companies. *See Gardner*, col. 4, lines 48-50. A requestor 18 of a company 12 may browse an electronic catalog stored on the central computer system 10 to order an item. *See Gardner*, col. 5, line 23, and col. 5, line 65-col. 6, line 1. Gardner also discloses that a requestor 18 may access the central computer system 10 by means of a worldwide web (WWW) homepage. *See Gardner*, col. 6, lines 17-19. However, there is no suggestion that this homepage is publicly accessible. Furthermore, as discussed above, Gardner discloses that the

requestors are principals or employees of the individual companies connected to the central computer system 10. There is nothing in the Gardner reference to suggest that any employees of any business other than those companies that could access the central computer system 10 to purchase goods. In other words, the website is only privately accessible.

The Examiner recognized this fact. In the Response to Arguments portion of the Office Action, the Examiner stated: "it is noted that King et al. show a private catalog viewable only by employees. As modified by Gardner et al. the private catalog is a web site, *but still private.*" (Emphasis added). Thus, neither the Gardner nor the King references, either alone or in combination, discloses or suggests "an electronic information system adapted to produce a publicly accessible website operable to provide job-function related information topics to employees of a plurality of businesses that access the website," as recited in amended independent claim 9. Therefore, the cited references do not disclose or suggest all of the recited features of claim 9.

The claims also are patentable because there is no suggestion to combine the references to obtain the currently claimed subject matter. First, the reasons provided by the Examiner in the Office Action for the combination cannot be found anywhere in the cited references. There is nothing in either reference that discloses or suggests to one of ordinary skill in the art to modify King by "using a web interface in order to take advantage of existing infrastructure and to reduce training costs for learning a custom interface," as stated by the Examiner. However, as noted above, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the *prior art* as a whole must suggest the desirability, and thus the obviousness, of making the combination. (Emphasis added). *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). Because the Examiner

has not relied on any evidence in the record to support the asserted reason for modification, it appears that the Examiner has taken official notice of facts outside of the record. Therefore, in accordance with M.P.E.P. § 2144.03, the Applicants hereby seasonably traverse and challenge the Examiner's use of official notice. Specifically, the Applicants respectfully request that the Examiner produce evidence in support of the Examiner's position as soon as practicable during prosecution and that the Examiner add a reference to the rejection in the next Official Action. If the Examiner finds such a reference and applies it in combination with the cited references, the Applicants further request that the Examiner specifically identify the portion of the newly cited reference that discloses or suggests the cited suggestion for the combination.

For the reasons set forth above, amended independent claim 9 is patentable over the cited references. Claims 11-22 depend from claim 9. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, Applicants respectfully submit that claims 11-22 are patentable over the cited references, and Applicants respectfully request withdrawal of this rejection.

Claims 31-37 and 39-43

In regard to independent claim 31, the Examiner stated that:

As to claim 31, King et al. show a computer system enabling an employee to get purchasing related job-function information and enabling the employee to order at least one of a good and a service from a menu authorized by the employer based on the employee's job-function. It also shows that the system automatically routes a purchase order to the employer for approval and payment. It is noted that the purchasing information provided by King et al. in the purchasing process is purchasing related job function information since the information is related to purchasing and is related to the performance of the employees' jobs. It

is also noted that the menu of authorized items (col. 5, lines 48-52) is provided based on the employee's job function. King et al. do not show that the information is provided by a website or that non-purchasing related job-function information is provided. Gardner et al. show that information and purchasing is provided via a website. *It would have been obvious to one of ordinary skill in the art to modify the apparatus of King et al. by providing the information via a website in order to provide a familiar interface and to use existing and common technology.* Providing non-purchasing related job-function information is notoriously old and well known in the art. For instance, this is practiced on the PTO intranet where data is presented at least partly by job function (for instance, position openings). It would have been obvious to one of ordinary skill in the art to further modify the apparatus of King et al. by providing job-related data on an intranet website in order to provide for streamline release of updated documentation.

(Emphasis added).

Claim 31 has been amended by this response. Amended independent claim 31 is patentable because the cited references do not disclose or suggest all of the recited features of the claim. None of the cited references, either alone or in combination, discloses or suggests "a *publicly accessible* website hosted by the computer system that enables *every purchaser* that accesses the website to order at least one of a good and a service from a menu, wherein, where the purchaser is an authorized employee of an employer, the computer system *automatically* routes a purchase order from the authorized employee to the employer for approval and payment after the authorized employee orders the at least one of the good and the service," as recited in claim 31. (Emphasis added).

As noted above, neither reference discloses a publicly accessible website, much less "a publicly accessible website hosted by the computer system that enables *every purchaser*

that accesses the website to order at least one of a good and a service from a menu,” as recited in claim 31. As noted above, there is no disclosure or suggestion in the Gardner reference that non-employees of the companies could access the central computer system 10 and order a product or service. Therefore, reference does not disclose or suggest “a website hosted by the computer system that enables *every* purchaser that accesses the website to order at least one of a good and a service from a menu,” as recited in amended claim 31. (Emphasis added).

Second, for all of the reasons provided above, there is no suggestion in the prior art to combine the King and Gardner references. In addition, as with claim 9 above, the reasons provided by the Examiner in the Office Action for the combination cannot be found anywhere in the cited references. There is nothing in either reference that discloses or suggests to one of ordinary skill in the art to modify King by “by providing the information via a website in order to provide a familiar interface and to use existing and common technology,” as stated by the Examiner. It appears that, once again, the Examiner has taken official notice of facts outside of the record. Therefore, in accordance with M.P.E.P. § 2144.03, the Applicants hereby seasonably traverse and challenge the Examiner’s use of official notice. Specifically, the Applicants respectfully request that the Examiner produce evidence in support of the Examiner’s position as soon as practicable during prosecution and that the Examiner add a reference to the rejection in the next Official Action. If the Examiner finds such a reference and applies it in combination with the cited references, the Applicants further request that the Examiner specifically identify the portion of the newly cited reference that discloses or suggests the cited suggestion for the combination.

Accordingly, claim 31 is patentable over the cited references. Claims 32-37 and 39-43 depend from claim 31. Therefore, claims 32-37 and 39-43 also are patentable over the cited references.

For all of these reasons, claims 9, 11-22, 31-37, and 39-43 are patentable over the cited references. Withdrawal of the rejection and allowance of the claims are respectfully requested.

Second Rejection Under 35 U.S.C. § 103

Claim 38 was rejected under 35 U.S.C. § 103(a) as being unpatentable over King, in view of Gardner, as applied to claims 31, 35, and 36, and further in view of Horstmann, U.S. Patent No. 6,363,356. Applicants respectfully traverse the rejection.

Claim 38 depends from amended independent claim 31. For the reasons provided above, claim 31 is patentable over the King and Gardner references. Furthermore, the Horstmann reference does not obviate the deficiencies of the King and Gardner references in failing to render claim 31 patentable that were described above. The Horstmann references does not provide the missing features of claim 31, nor the missing suggestion to combine that is lacking the in the King and Gardner references. Therefore, claim 31, as well as claim 38, are patentable over the cited references. Withdrawal of the rejection and allowance of the pending claim are respectfully requested.

Conclusion

In view of the above remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: March 10, 2004

A handwritten signature in dark ink, appearing to read 'R. A. Graham', written over a horizontal line.

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